

Remarks

Claims 9-12, 21-30, and 32-77, and 79 are pending in the application. The Applicants note that due to a typographical error in the instant application, there was never a pending claim 31.

Response to Rejections Based on 35 U.S.C. § 103(a)

Claims 9-12 stand rejected under 35 U.S.C. § 103(a) based on the Examiner's contention that they are obvious over Vyskocil et al. (*Tetrahedron Lett.*, **1998**, 39, 9289) in view of Inanaga et al. (U.S. Patent No. 6,274,745). The Applicants respectfully traverse this contention.

US 6,274,745 is Not Available as Prior Art Against the Instant Application

The Applicants respectfully remind the Examiner of the priority-claim and filing-date histories of the instant application and its parent applications. The instant application ("the '101 application") is a continuation of USSN 09/231,315 ("the '315 application"), filed January 13, 1999, now U.S. Patent 6,307,087. The '315 application was a continuation-in-part of USSN 09/113,478 ("the 478 application"), filed July 10, 1998, now US Patent 6,395,916.

Therefore, the effective filing date of the instant application is no later than January 13, 1999 (the filing date of the '315 application). MPEP § 706.02 Rejections On Prior Art ("The effective filing date of a U.S. application may be determined as follows: (A) If the application is a continuation or divisional of one or more earlier U.S. applications and if the requirements of 35 USC 120 have been satisfied, the effective filing date is the same as the earliest filing date in the line of continuation or divisional applications."). Moreover, the Applicants respectfully contend that the effective filing date of the instant application is July 10, 1998 (the filing date of the '478 application). MPEP § 706.02 Rejections On Prior Art ("The effective filing date of a U.S. application may be determined as follows: (B) If the application is a continuation-in-part of an earlier U.S. application, any claims in the new application not supported by the specification and claims of the parent application have an effective filing date equal to the

filing date of the new application. Any claims which are fully supported under 35 U.S.C. 112 by the earlier parent application have the effective filing date of that earlier parent application.).

Turning to Inanaga et al. (US 6,274,745; “the Inanaga patent”), the Applicants respectfully assert that it is not available as prior art against the instant application even if one looks only to the filing date of the ‘315 application (January 13, 1999) to establish the effective filing date of the instant application (NB: this approach ignores the Applicants’ position that the instant application is entitled to an effective date equal to the filing date of the ‘478 application (July 10, 1998)). The Inanaga patent issued on August 14, 2001; this date is after the filing date (January 13, 1999) of the ‘315 application. Therefore, the Inanaga patent does not qualify as prior art against the instant application based on its issue date. Further, the earliest effective filing date available to the Inanaga patent is March 22, 2000; which date is also after the filing date (January 13, 1999) of the ‘315 application. MPEP § 706.02 Rejections On Prior Art (“The effective filing date of a U.S. application may be determined as follows: (C) If the application claims foreign priority under 35 U.S.C. 119(a)-(d), the effective filing date is the filing date of the U.S. application, unless situation (A) or (B) as set forth above applies. The filing date of the foreign priority document is not the effective filing date....”).

To summarize, the Applicants respectfully contend that the Inanaga patent is not available as prior art against the instant application. MPEP § 2141.01 Scope and Content of the Prior Art (“A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date.”). First, because the Inanaga patent issued after the effective filing date of the instant application, i.e., the Inanaga patent does not qualify as prior art under 35 USC 102(a) or (b). Second, because the earliest effective filing date attributable to the Inanaga patent is March 22, 2000, which date is after the effective filing date of the instant application; i.e., the Inanaga patent does not qualify as prior art under 35 USC 102(e).

Vyskocil is Not Available as Prior Art Against the Instant Application

As discussed in detail in the preceding section, the Applicants respectfully contend that the effective filing date of the instant application is July 10, 1998 (the filing date of the '478 application). MPEP § 706.02 Rejections On Prior Art ("The effective filing date of a U.S. application may be determined as follows: (B) If the application is a continuation-in-part of an earlier U.S. application, any claims in the new application not supported by the specification and claims of the parent application have an effective filing date equal to the filing date of the new application. Any claims which are fully supported under 35 U.S.C. 112 by the earlier parent application have the effective filing date of that earlier parent application.).

Turning to Vyskocil, the second publication relied upon by the Examiner for the obviousness rejection, careful review of the by-line on page 9289 reveals that the manuscript was submitted to the journal (*Tetrahedron Letters*) for consideration on August 20, 1998; it was accepted for publication on October 1, 1998. Therefore, Vyskocil could not have been published before October 1, 1998. Moreover, given the time required to typeset, print and distribute an issue of a scientific journal, the Applicants believe Vyskocil could not have been published before November 1, 1998 (we have not, but could, determine the actual publication date of Vyskocil).

Therefore, the Applicants respectfully assert that Vyskocil is not available as prior art against the instant application because it was published after the effective filing date of the instant application; i.e., the filing date of the '478 application, July 10, 1998. MPEP § 2141.01 Scope and Content of the Prior Art ("A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date.").

Prima Facie Showing of Obviousness

The Applicants respectfully contend that the Examiner has failed to meet the burden of establishing a *prima facie* showing of the obviousness of the rejected claims because neither reference relied upon by the Examiner qualifies as prior art vis-à-vis the instant application.

Accordingly, the Applicants respectfully request the withdrawal of the claim rejections under 35 U.S.C. § 103(a).

Allowable Subject Matter

The Examiner in his office action dated February 17, 2004, indicated that claims 21-30, 32-77, and 79 are not rejected over any prior art. The Applicants appreciate this indication and respectfully submit that the response presented herein also renders allowable the remaining pending claims.

Fees

The Applicants believe there are no required fees in connection with the filing of this paper. Nevertheless, the Director is hereby authorized to charge any required fee to our Deposit Account, 06-1448.

Conclusion

For the foregoing reasons, the Applicants respectfully request reconsideration and withdrawal of the pending rejections. Applicants believe that the pending claims are now in condition for allowance and early notification to this effect is earnestly solicited. If any questions are raised by this Response, the Examiner is urged to contact the undersigned at the telephone number listed below.

Respectfully submitted,
Patent Group
Foley Hoag LLP

By: 

Dana M. Gordon, PhD
Reg. No. 44,719
Attorney for Applicants

155 Seaport Boulevard
Boston, MA 02210
Telephone: (617) 832-1000
Telecopier: (617) 832-7000

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